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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,907	03/15/2004	Peter S. Schulte	29020/320A	1494

34431 7590 10/18/2006

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EXAMINER

REDMAN, JERRY E

ART UNIT PAPER NUMBER

3634

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,907

Applicant(s)

SCHULTE, PETER S.

Examiner

Jerry Redman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) 1-27 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 28-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Applicant's election with traverse of Group I in the reply filed on 8/7/2006 is acknowledged. The traversal is on the ground(s) that there would not be a serious burden on the Examiner because all of the searching would be in a single class/subclass. This is not found persuasive because at the outset, it appears from applicant's arguments that applicant has not analyzed the examiner's action in the context of the established practice for requiring a provisional election of inventions/species as established in Chapter 800 of the MPEP. It is a well-established practice that a requirement to elect a single disclosed invention as well as a single disclosed species is a holding by the examiner that the plural inventions and species, as claimed, are patentably distinct, i.e., capable of supporting separate patents. See MPEP 808.01(a) and MPEP 809.02(a). If the applicant is of a different view, then applicant need merely clearly state on the record that the inventions or species are not patentably distinct. Neither the examiner nor the applicant needs to present any reasoning. Of course, it should be noted that the inventions or species that are not patentably distinct for restriction purposes are also not patentably distinct (i.e., obvious in view of one another) for rejection purposes. Applicant's response implies that the various identified inventions or species are **not** considered to be patentably distinct. If such is the case, then applicant must clearly admit this on the record or point to evidence already of record.

Furthermore, with respect to applicant's species argument, it is noted that the examiner fully complied with the required and well-established procedures pertaining to the making of a provisional election requirement. The procedures are clearly and

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explicitly outlined in MPEP 809.02(a). Further, MPEP 817 clearly states that “(t)he statement in MPEP § 809.02- § 809.02(d) is adequate indication of the form of letter when an election of species is required.” Further, MPEP 806.04(h) clearly states that the examiner is to group together species that are clearly unpatentable over each other. Thus, it is inherently quite evident that species **not** grouped together are considered to be patentably distinct from the other separately listed species.

Still furthermore, the implication that applicant is otherwise unable to ascertain the basis for the grouping of species, i.e., why they are patentably distinct from each other is not well taken. In particular, applicant’s attention is directed to the instant specification wherein several “embodiments” are each specifically and individually disclosed and described with respect to the features thereof. Accordingly, it is quite evident from this disclosure, as well as perusal of the respective figures of each species grouping alone or in combination with the written description, that the reason the embodiments are considered to be patentably distinct is that each embodiment encompassed a separate invention.

With respect to the above and applicant’s response, it is noted that applicant has failed to point out why each, or any, of these identified species are not patentably distinct. Yet, still furthermore, the applicant’s response of there not being a serious burden on the Examiner because the search is in the same class is not convincing. If this were the case, then why would there be subclasses, which further defines inventions?

Furthermore, it is noted that applicant's own response clearly evidences the presence of claims reciting mutually exclusive characteristics and thus is fully supportive of the examiner's action of requiring an election of inventions and species. In particular, by applicant's own hand, the claims "mutually excluded" from the invention and elected species have been clearly identified. Nevertheless, it appears that applicant has taken the first sentence of MPEP 806.04(f) out of context with the implication that some particular requirement of action is being imposed on the examiner that must be conveyed to applicant in an election of inventions/species letter before an election requirement can be considered proper. However, continued reading of MPEP 806.04(f) does not bear this out and neither MPEP 806.04(h), MPEP 808.01(a), MPEP 809.02(a), nor MPEP 817 indicate that the "general test" indicated by MPEP 806.04(f) is nothing more than a mental exercise on the part of the examiner in determining whether or not to proceed with an election of species requirement.

Still furthermore, it is noted that applicant has (1) failed to show that a coextensive search is a reason for not requiring an election requirement and (2) failed to establish that a coextensive search is present. Yet still furthermore, applicant has failed to show that a search is the overriding criteria in determining the burden imposed upon the examiner.

Applicant's general allegation that "search and examination of the entire application would not place a *serious* burden on the Examiner" (emphasis applicant's) fails to comply with the requirement of 37 CFR 1.111 and is wholly insufficient. In particular, what is the basis relied upon to arrive at the conclusion that no serious

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burden is imposed? Is applicant alleging that the examiner would only have to consider the patentability of the generic aspects of the invention? Is applicant asserting that the numerous species are not patentably distinct and thus are obvious in view of one another? Is applicant asserting that all claims stand or fall with the patentability determination of claim 1 and thus separate arguments directed toward each individual species would not have to be considered? Nevertheless, it is extremely burdensome to have to carry out an examination, including consideration of and response to arguments, for all of the specific features of each of the multiple patentably distinct invention/species in the same application when no patentable generic claim is indicated to be present.

Finally, applicant should note with respect to species and an election of species requirement in general that there are two and only two alternatives available and each alternative is an absolute and is mutually exclusive of the other. In particular, species can *only* be either (1) patentably distinct or (2) not patentably distinct. There is no middle ground between these two choices. If the species are patentably distinct, they are restrictable. If the species are not patentably distinct, then they are not restrictable. The examiner, in accordance with well-established practice and procedure, has clearly indicated a position that the various species, are patentably distinct. Applicant's response appears to take issue with this position and thus appears to be taking the opposite position that the various species are not patentably distinct. In other words, if applicant objects to the examiner's holding that the species are patentably distinct, then it inherently follows that applicant is asserting that the species are not patentably distinct

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because that is the only alternative left. If this is correct, then applicant should clearly admit on the record that the various identified species are not patentably distinct. If this is not a correct interpretation of applicant's response, then applicant should clearly explain what the interpretation should be.

The provisional election requirement is still deemed to be proper and remains in effect.

The requirement is still deemed proper and is therefore made FINAL.

In summary;

Claims 1-27 are hereby withdrawn from consideration; and

Claims 28-32 are herein addressed below.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Delaney et al. (5,960,849). Delaney et al. ('849) disclose a method of moving a door panel (12) comprising a cable (24), a position/proximity sensor (118), a sensor switch (140), and a slack condition detection system (200 and 202).


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. patents to McCartney et al. Hormann, Krupke et al., and

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Siegler et al.; European patent No. 393 489 to Hormann, and Japanese patent No.

2002-227520 disclose various types of cable tensioners for movable closures similar to that of the applicant's invention.

Any inquiry concerning this communication should be directed to Jerry Redman at telephone number 571-272-6835.



Jerry Redman
Primary Examiner